

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

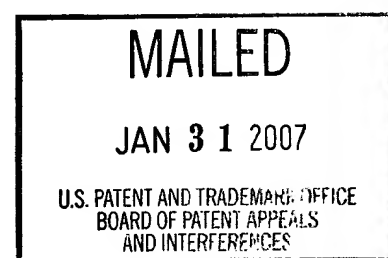
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TETSUO NISHIKAWA,
KAZUO HARUTA,
TOSHIAKI SAKAKI, and
TETSUO MIZOGUCHI

Appeal No. 2006-2811
Application No. 09/973,646

ON BRIEF



Before GRIMES, LINCK, and LEOVITZ, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims to a thermoplastic resin. The examiner has rejected the claims as anticipated or obvious. We have jurisdiction under 35 U.S.C. § 134. We reverse.

Background

The present application was filed on October 9, 2001. The Declaration filed with the application lists four inventors. It also refers to a prior application, JP 11-95712, filed in Japan on April 2, 1999, but indicates that priority is not claimed.

The specification of the present application describes a thermoplastic resin composition comprising an elastomer and tungsten powder. See page 2. The composition is said to be useful as a substitute for lead in forming articles such as balance weights. Id.

Discussion

1. Claims

Claims 1, 3-7, 12, 16-19, 22, and 23 are on appeal. Claims 20 and 21 are also pending but are not rejected. We will focus on claim 1, the broadest claim on appeal, which reads as follows:

1. A thermoplastic resin composition comprising 2.5 to 15 wt[.]% of a styrene-based thermoplastic elastomer and 85 to 97.5 wt.% of tungsten powder.

2. Sakaki

The examiner has rejected claims 1, 3-7, 12, 16-19, 22, and 23 under 35 U.S.C. § 102(e) as anticipated by Sakaki.¹ The examiner argues that Sakaki describes a composition that anticipates claim 1. Examiner's Answer, page 3.

Appellants argue that Sakaki is not available as prior art against the present claims based on two declarations under 37 CFR § 1.132 that "unequivocally state[] that the named inventors in the present application invented the thermoplastic resin composition which is used to manufacture one of the elements of the balance weight claimed in Sakaki." Appeal Brief, pages 4-5.

Each of the Rule 132 declarations state "that we are the true inventors of the thermoplastic resin composition containing 2.5 to 8.0% by weight of a thermoplastic

¹ Sakaki, U.S. Patent No. 6,364,422 B1, which issued April 2, 2002, from an application filed August 18, 2000.

elastomer and 97.5 to 92% by weight of tungsten powder, . . . that we disclosed [this] thermoplastic resin . . . to the inventors of U.S. Patent No. 6 364 422 [i.e., Sakaki], and that the use of [this] thermoplastic resin composition . . . in U.S. Patent No. 6 364 422 . . . was based solely on our disclosure of the subject matter described in the [present] application.” Pages 1-2. One of the Rule 132 declarations is signed by inventor Kazuo Haruta; the other Rule 132 declaration is signed by the three other inventors.

The examiner argues that these declarations were “not successful in removing Sakaki et al. as a reference against the present claims.” Examiner’s Answer, page 8. In particular, the examiner argues that “there is no indication in either declaration that the ‘we’ collectively refers to all four inventors. . . . Rather, the 10/14/03 declaration states that Sakaki, Mizoguchi, and Nishikawa are the true inventors . . . while the 2/26/04 declaration states that Haruta is the true inventor.” Id., pages 8-9. Thus, the examiner argues that there “is no disclosure in either declaration that Sakaki, Mizoguchi, Nishikawa, and Haruta, the inventors of the present application, are the true inventors.” Id., page 9.

We agree with the examiner that the Rule 132 declarations could be better written and that a more careful construction of these documents may have avoided the necessity of an appeal. In particular, we agree with the examiner that use of the term “we” in, for example, the statement that that “we are the true inventors of the thermoplastic resin composition” is somewhat ambiguous. However, Appellants stated that the declaration signed by Mr. Haruta was submitted separately because he “was not able to sign the [first Rule 132] Declaration because he was hospitalized and

quarantined.” Response received February 26, 2004, page 2. Appellants also stated that the second Rule 132 declaration was intended to show that “Mr. Haruta . . . along with the three prior declarants, are the true inventors” of the elastomer/tungsten composition disclosed by Sakaki. The Rule 132 declarations also state that “[w]e are the inventors of the invention described and claimed in application Serial No. 09/973 646, filed on October 9, 2001,” and Declaration filed with the application includes all four of the present inventors. Thus, we agree with Appellants that the evidence of record shows “the ‘we’ stated in the Declarations collectively refers to all four of the present inventors.” Appeal Brief, page 5.

The examiner also notes that the Rule 132 declarations, on page 2, lines 2-4, state “that the ‘entitled Balance Weight for Vehicle Wheel was invented independently by the inventors of U.S. Patent No. 6,364,422.’” Examiner’s Answer, page 10. The examiner argues that this statement

appears to contradict the rest of the declaration. That is, the declaration is made to establish the inventors of the present application are the true inventors of Sakaki et al., i.e. US 6,364,422, however, by stating the US 6,364,422 was invented “independently” by the inventors of US 6,364,422, namely, Sakaki, Kadomaru, and Mizoguchi, it appears that the inventors of the present application are not the true inventors of US 6,364,422 which as disclosed by applicants was invented “independently” by Sakaki, Kadomaru, and Mizoguchi.

Id.

The examiner seems to misapprehend the point of the Rule 132 declarations. These declarations are intended to show that the invention claimed in the present application was invented by the present applicants. That is, the point of the declarations

is that the present applicants invented the composition of instant claim 1, while the applicants in Sakaki invented a wheel balance weight made from that composition.

We agree with Appellants that the statements in the Rule 132 declarations do not contradict each other. The declarations state that the inventors of the present application invented a thermoplastic resin composition and molded articles formed from the resin composition. The declarations do not state that the inventors of the present application invented the balance weight claimed in Sakaki. Thus, the statement that the inventors of Sakaki invented the balance weight does not contradict the statements in the declarations that the present inventors invented the thermoplastic resin composition and molded articles formed from the resin composition.

The Rule 132 declarations adequately show that Sakaki is not prior art with respect to the present claims. Therefore, we reverse the rejection of claims 1, 3-7, 12, 16-19, 22, and 23 under 35 U.S.C. § 102(e) over Sakaki.

3. Gallucci

The examiner has rejected claims 1, 4-7, 16-19, 22, and 23 under 35 U.S.C. § 102(e) as anticipated by Gallucci.² The examiner argues that Gallucci discloses a composition that anticipates claim 1. Examiner's Answer, page 4.

Appellants argue that "the inventions of Claims 1, 3-7 and 12 were actually reduced to practice by the Applicants in Japan" as of April 2, 1999. Appeal Brief, page 6. Specifically, Appellants argue that the Declaration under 37 CFR § 1.131 of record "establishes a reduction to practice of the subject matter of Claims 1, 3-7 and 12 as of

² Gallucci et al., U.S. Patent No. 6,300,399 B1, which issued October 9, 2001, from an application filed November 18, 1999.

the filing date of JP 11-95712, that is, April 2, 1999.” Id. Appellants argue that, in the Rule 131 declaration, “JP 11-95712 was used to establish an actual reduction to practice. . . . Since JP 11-95712 was not abandoned, suppressed or concealed, it can serve as evidence of a reduction to practice if it is shown that (1) an embodiment was constructed that met every element of the subject claims and (2) the embodiment operated for its intended purpose. . . . As shown in the verified English-language translation of JP 11-95712, Examples 1-5 produced molded articles from the thermoplastic resin compositions which clearly fall within the scope of claims 1, 3-7 and 12.” Id., page 8.

We conclude that the Rule 131 declaration provides sufficient evidence of an actual reduction to practice of the examples included in JP 11-95712. The filing of an application is not an actual reduction to practice. However, the information provided in an application can be used as evidence of an actual reduction to practice. In the present case, JP 11-95712 includes examples that appear to be within the scope of claims 1, 3-7, and 12.

The Rule 131 declaration does not expressly state that these examples were conducted by or under the direction of the present inventors in Japan prior to the filing of JP 11-95712. However, the Rule 131 declaration states that it is being presented “to establish completion of the invention . . . in a WTO member country, Japan, at a date prior to August 27, 1999, the earliest U.S. effective filing date of . . . Gallucci,” and that the inventors are citizens and residents of Japan. In addition, the examples in JP 11-95712 are in the past tense and include numerical results, indicating that they are actual rather than prophetic examples. Finally, the inventors have stated in the above-

mentioned Rule 132 declarations that they are the inventors of the claimed subject matter, which is exemplified by these examples. Based on the totality of the evidence provided in the record, we conclude that the Rule 131 declaration is sufficient to establish that the examples presented in JP 11-95712 were actually reduced to practice in Japan as of the filing date of JP 11-95712, which is before the effective filing date of Gallucci.

The examiner argues that “the certified English translation [of JP 11-95712] is not evidence of reduction to practice. Rather, it only serves to confirm evidence of conception,” which, in the absence of a demonstration of due diligence, is insufficient to establish an earlier date of invention. Examiner’s Answer, page 12. In support of this position, the examiner relies on In re Costello, 717 F.2d 1346, 219 USPQ 389 (Fed. Cir. 1983). However, Costello relates to whether a prior application that had been abandoned provides a constructive reduction to practice. We agree with Appellants that Costello is not relevant to whether a prior application can be used as evidence of an actual reduction to practice. Appeal Brief, page 8.

We are aware of no reason why an application cannot be used as evidence of an actual reduction to practice. In the present case, we conclude that the prior application, together with the Rule 131 declaration, provides sufficient evidence of an actual reduction to practice of the examples described in the prior application, prior to the effective filing date of Gallucci. Thus, we agree that Appellants have presented sufficient evidence that Gallucci is not prior art with regard to claims 1, 3-7, and 12.

Appellants do not assert that they have antedated Gallucci with respect to the rejection of claims 16-19, 22, and 23. These claims are directed to the composition of

claim 1, or a molded article made from it, further or optionally comprising one of several specified metals or metal salts. With respect to these claims, we reverse because we conclude that the examiner has not set forth a prima facie case that Gallucci anticipates claim 1.

Gallucci describes a molding composition comprising 5 to 40 wt.% polyester resin, 60 to 95 wt.% tungsten metal filler, and optionally 0 to 20 wt.% impact modifier. Col. 2, lines 11-18. Gallucci states that the tungsten metal filler comprises particles of tungsten metal and that the amount of tungsten is preferably from 65 to 85%. Col. 3, lines 20-22 and 44-45. Gallucci lists styrene-containing polymers as impact modifiers and states that the impact modifiers are preferably used in an amount less than about 10% and most preferably less than about 5%. Col. 4, lines 28-29; col. 3, lines 50-54.

The examiner argues that Gallucci describes a “composition comprising about 60 to about 95 wt.% tungsten which clearly overlaps the amount of tungsten presently claimed and 1-10% impact modifier.” Examiner’s Answer, page 17. In addition, the examiner argues that, although Gallucci discloses “the use of impact modifiers other than styrene-based elastomers as presently claimed, . . . the choice of styrene-based elastomers is not from amongst a vast number of impact modifiers disclosed by Gallucci et al. but only from amongst a group of five.” Examiner’s Answer, page 17.

Appellants argue that “there is no specific disclosure in [Gallucci] of a composition which falls within the scope of the present claims. The impact modifier of this reference is optional and the use of a styrene-containing polymer as the impact modifier is also optional.” Appeal Brief, page 10. In addition, Appellants note that “Examples 3 and 4 in Table 1 and Examples 9 and 10 in Table 2 of this reference are

the only specific compositions which use styrene-containing resins as impact modifiers. However, Examples 3, 9 and 11 [sic, 10] only contain 80 wt.% tungsten powder and Example 4 contains 81 wt.% tungsten powder. Since the currently presented claims require a minimum of 85 wt.% tungsten powder, Gallucci et al clearly does not anticipate the presently claimed invention.” Id.

For the reasons stated by Appellants, we conclude that the examiner has not set forth a prima facie case that Gallucci describes a composition in which the optional impact modifier is included, the impact modifier is a styrene-based thermoplastic elastomer, the styrene-based thermoplastic elastomer is included in an amount of 2.5 to 15 wt.%, and tungsten powder is included in an amount of from 85 to 97.5 wt.%. See Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (“Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.”). We therefore reverse the rejection of claims 1, 4-7, 16-19, 22, and 23 under 35 U.S.C. § 102(e) over Gallucci.

4. Obviousness

The examiner has rejected claims 3 and 12 under 35 U.S.C. § 103 as obvious over Gallucci in view of Sakaki. We have already concluded that Sakaki cannot be applied as prior art against the present claims and that Appellants have antedated Gallucci with respect to claims 3 and 12. We therefore reverse the obviousness rejection of these claims.




The examiner has also rejected claims 16-19 under 35 U.S.C. § 103 as obvious over Sakaki in view of Gallucci. We have already concluded that Sakaki cannot be applied as prior art against the present claims and that Gallucci does not anticipate

claim 1. Furthermore, the examiner has not set forth a prima facie case that claim 1, or a molded article made from it, with or without the additional component recited in claims 16-19, would have been obvious over Gallucci alone. Thus, the examiner has not set forth a prima facie case that claims 16-19 would have been obvious over Gallucci alone. We therefore reverse the obviousness rejection of these claims.

Summary

Appellants have adequately shown that the relevant disclosure in Sakaki was derived from their own work and that they reduced to practice the invention of claims 1, 3-7, and 12 before the effective filing date of Gallucci. The examiner has not shown that the remaining claims were anticipated or would have been obvious to a person of ordinary skill in the art based on Gallucci alone. We therefore reverse the rejections on appeal.

REVERSED

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Eric Grimes)	
Administrative Patent Judge)	
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Nancy J. Linck)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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